

REMARKS

Applicants have timely submitted this response to the Examiner's Office Action of July 1, 2004. The Office Action has been carefully reviewed and the following remarks are made in response thereto. In view of the following remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

I. Summary of the Office Action

1. Claims 1-24 are currently pending.
2. Claims 1-24 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn.
3. No claims were allowed.

II. Response to the Office Action

1. **Rejection of the claims under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn.**

Claims 1-24 were rejected under 35 U.S.C. § 103(a) as purportedly obvious over Webfeat and Hoyt *et al.* and Msdn. Applicants respectfully traverse this rejection.

Respectfully, the Examiner fails to establish a *prima facie* case of obviousness for three reasons. First, the Examiner fails to establish that the cited references Webfeat and Msdn are prior art. Second, the cited references, Webfeat, Msdn, and Hoyt *et al.* neither disclose nor suggest, either alone or in combination, each and every element of the claimed methods and systems. Third, the Examiner fails to provide motivation to modify or combine the cited references by either: a) completely failing to identify reasons why a skilled artisan would modify or combine the teachings of the cited references to obtain the claimed invention or b) failing to consider the cited references as a whole.

A. Webfeat and Msdn are not prior art.

i. Webfeat

Applicants respectfully traverse the availability of Webfeat as a reference because the only date listed on the reference is June 13, 2004 – well after the filing date of this application. Although this appears to be the date the Examiner printed the reference, no date of publication or public availability is provided. In an attempt to establish the reference as prior art, the Examiner relies on a statement in a separate article located at <http://www.libraryjournal.com/index.asp?layout=articlePrint&articleID=CA200892> to date the Webfeat knowledge prism to 1998 (*See*, Office Action paragraph 1, page 1). However, nothing on the Library Journal webpage identifies what occurred in 1998 or identifies the date the Webfeat system was either invented, published, or otherwise made available to the public. A publication is available as prior art under 35 U.S.C. § 102 when it is “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it” *In re Wyer*, 665 F.2d 221, 226 (CCPA 1981). By failing to establish the date of publication of the Webfeat reference, the Examiner has failed to establish Webfeat as prior art to the claimed invention under any section of 35 U.S.C. § 102. Because the Examiner relied on the Webfeat reference to reject claims 1-24, and because the Examiner has not established that the Webfeat reference is prior art, the Examiner has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants therefore respectfully request that this rejection of claims 1-24 be withdrawn, and that the pending claims be allowed.

ii. Msdn

Similarly, Applicants respectfully traverse the availability of Msdn as prior art because its publication date is unknown. Again, the only date on the Msdn reference is June 13, 2004. This reference provides absolutely no indication of when the Msdn

system or services were invented, published, or otherwise made available to the public. A publication is available as prior art under 35 U.S.C. § 102 when it is “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it” *In re Wyer*, 665 F.2d 221, 226 (CCPA 1981). By failing to establish the date of publication of the Msdn reference, the Examiner has failed to establish Msdn as prior art to this application under any section of 35 U.S.C. § 102. Because the Examiner relied on the Msdn reference to reject claims 1 – 24, and because the Examiner has not established that the Msdn reference is prior art, the Examiner has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

Applicants therefore respectfully request that this rejection of claims 1-24 be withdrawn, and that the pending claims be allowed.

B. Each and every element of the claimed invention is not disclosed or suggested by the cited references.

The Webfeat reference does not disclose or suggest each and every element of the claimed methods and systems. Specifically, Webfeat does not disclose or suggest a user computer, a library system computer, and a content provider computer. Furthermore, Webfeat does not disclose or suggest interaction between the user computer and the library system computer; the library system computer and the user computer; the library system computer and the content provider computer; and the content provider computer and the library system computer.

The Examiner does not assert that Webfeat discloses or suggests “interactive”. Instead, the Examiner alleges that Msdn is “interactive” in nature and is thus equivalent to the claimed methods and systems. The Examiner, however, provides no basis for this inferred equivalence and fails to consider the reference as a whole, most notably, by ignoring the limitation of the reference that only one window station can be interactive. The claimed methods and systems, on the other hand, are not limited. Consequently, the Applicants respectfully traverse the Examiner’s finding that Msdn teaches this element.

Applicants respectfully request withdrawal of the Examiner's rejection of claims 1-24 and early notification of allowance.

C. The Examiner's reasoning constitutes improper hindsight reconstruction.

The Examiner does not consider the cited references as a whole. In determining the differences between the prior art and the claims at issue, the Examiner must consider both the claimed invention and the references as a whole. MPEP §§ 2111-2116.01; 2141.02. When determining the differences between the prior art and the claims, the operative question is not whether the differences themselves would have been obvious, but whether the invention as a whole would have been obvious to one of ordinary skill in the art at the time the invention was made. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). For example, the Examiner generalizes the teaching of "interactive" for the purpose of creating the claimed invention, without considering either the reference as a whole or the claimed invention as a whole. This generalization of the Msdn relevance focuses on the obviousness of the difference between the cited references and the claimed invention – not the obviousness or nonobviousness of the invention as a whole. Applicants respectfully submit that this is impermissible hindsight reconstruction. *See, In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); MPEP § 2143 and 2143.03.

Applicants therefore respectfully request that the rejection of claims 1-24 be withdrawn, and that the pending claims be allowed.

D. The Examiner ignores elements of dependent claims 3-17 and 19-24.

The references cited by the Examiner do not disclose or suggest each and every element of dependent claims 3-17 and 19-24. The Examiner improperly relies on a bare assertion that elements missing from the cited references were purportedly known in the art at the time of filing. These assertions are unsupported by any evidence or reference. Applicants respectfully traverse this treatment of the claims.

i. Insufficient *prima facie* case of obviousness.

The Examiner's rejection of independent claims 1 and 18 is insufficient to support a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Consequently, the Examiner's rejection of the independent claims fails as a matter of law.

ii. Improper reliance on knowledge in the art.

The Examiner's reliance on official notice to support substantive non-trivial facts that are incapable of unquestionable demonstration of being well known ignores limitations of the dependent claims and cannot support the rejection under 35 U.S.C. § 103(a).

With respect to claims 3, 6-11, and 19-24, the Examiner takes official notice of the state of the art and states "such account and access handlings was well known in the art for the motivation of accuracy of billing and security." With respect to claims 4 and 5, the Examiner takes official notice of the state of the art and states "such access restriction to Deal Room was well known in the art for the motivation of security." With respect to claims 12-17, the Examiner takes official notice of the state of the art and states "such handlings of usage was well known in the art for the motivation of accuracy of billing and security." Applicants respectfully disagree.

Reliance on official notice is permissible under only very limited circumstances. Official notice without documentary evidence to support an examiner's conclusion should be taken only on the rare occasion when the noticed fact is capable of instant and unquestionable demonstration as being well known. (*See*, MPEP § 2144.03; *see also*, *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970)). That is not the case here.

Applicants respectfully note that broad notice that, for example, "such account and access handlings was well known in the art for the motivation of security" does not take into account the specific methods recited by the claims. Moreover, by taking official notice of "account and access handlings", the Examiner ignores recited elements of the

claims. These elements are not disclosed or suggested by any reference cited by the Examiner, and the fact is not of the type for which official notice is appropriate.

Applicants therefore respectfully request that the rejection of claims 3-17 and 19-24 be withdrawn, and that the Examiner allow all pending claims.

III. Conclusion

Applicants believe that the above-referenced application is in condition for allowance. Reconsideration and withdrawal of the outstanding rejections and early notice of allowance to that effect is respectfully requested.

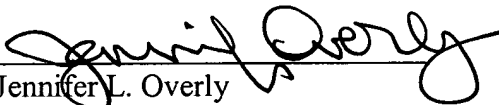
EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Director is hereby authorized by this paper to charge any additional fees during the entire pendency of this application, including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 13-3250, reference No. 02012.4121. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

If the Examiner finds that a telephone conference would further prosecution of this application, the Examiner is invited to contact the undersigned at 202-835-7512.

Respectfully submitted,

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Dated: October 1, 2004


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